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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,761	10/05/2001	Akihiko Toyoshima	50P4257.01	4602
36738	7590	11/01/2005	EXAMINER	
ROGITZ & ASSOCIATES			TRAN, PHUC H	
750 B STREET			ART UNIT	
SUITE 3120			PAPER NUMBER	
SAN DIEGO, CA 92101			2668	

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Ex

Office Action Summary

Application No.

09/972,761

Applicant(s)

TOYOSHIMA, AKIHIKO

Examiner

PHUC H. TRAN

Art Unit

2668

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,5 and 7-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,4,5 and 7 is/are allowed.
- 6) ☒ Claim(s) 8-12,14 and 15 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claim 8 is rejected under 35 U.S.C. 102(e) as being anticipated by Hartmaier (U.S. Patent No. 6304753 B1).

- With respect to claim 8, Hartmaier teaches a method for activation of a wireless module, said method comprising:

providing the wireless module with initialization data (202 in Fig. 2);

establishing a wireless module account with an activation center (208 in Fig. 2);

transmitting operational data including a permanent IP address to the wireless module from the activation center once the wireless module account is established (524 in Fig. 5); and providing the permanent Internet protocol address for use by the wireless module until the

wireless module is reset or deactivated (it is inherently to know that when the mobile deactivated, the permanent IP address also deactivate for the mobile).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9-12, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harmaier (U.S. Patent No. 6304753 B1) in view of Nordman (U.S. Patent No. 6061346).

- With respect to claim 11, Hartmaier teaches a system for activation of a wireless module, said system comprising:

the wireless module configured to transmit initialization data and receive operational data (e.g. the mobile in Fig. 1); and

a user activation web site in electronic data communication with the wireless module and said peripheral unit (e.g. block 130 in Fig. 1), said user activation web site configured to receive said initialization data and transmit said operational data (block 506-512 in fig. 5), the initialization data including an electronic serial number and a preliminary address (e.g. the ESN/MIN in Fig. 5), the operational data including a permanent address different from the preliminary address (e.g. TIP and PIP). Hartmaier fails to teach a peripheral unit electrically connected to the wireless module. Nordman teaches the peripheral unit electrically connected to the wireless module (e.g. Fig. 1). Therefore, it would have been obvious to a person of ordinary

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skill in the art at the time of the invention was made to utilize the wireless module to connect between the peripheral unit and data network for communication.

- With respect to claim 12, Hartmaier further comprises a base station in electronic data communication with the wireless module and said user activation web site, said base station configured to receive and transmit said initialization data and said operational data (e.g. the base station in Fig. 1 communicate with data network).

- With respect to claims 9-10, & 14-15, Hartmaier discloses all the aspect of the claimed invention as set forth above but also fails to teach wherein transmitting operational data comprises transmitting, storing a permanent internet protocol address. Nordman also teaches the transmitting and storing a IP address (col. 6, lines 12-20) for communication between wireless module and IP network. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to implement the steps of transmitting and storing a IP address for communication between the wireless module and IP network.

Response to Amendment

5. Applicant's arguments with respect to claims 8-12, and 14-15 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

6. The following claim 8 was indicated allowable by examiner in previous office action; however, these claims are unpatentable in view of new arts. Therefore, these indicated claims are withdrawn.

7. Claims 1, 4, 5, 7 are allowed.

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8. Claim 13 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hartmaier (U.S. Patent No. 6304753 B1) discloses integration of voice and data service provided to a mobile wireless device.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHUC H. TRAN whose telephone number is (571) 272-3172. The examiner can normally be reached on M-F (8-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chieh M. Fan can be reached on (571) 272-3042. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Phuc Tran
Assistant Examiner
Art Unit 2664

P.t
6/21/05



DOUG TON
PATENT EXAMINER